

REMARKS

Claims 32-54 remain in this application. No claims have been added, cancelled, or amended. The Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

Clarification of Former Amendment to Specification

In the Response to Office Action mailed 3/3/04, the sentence beginning at page 5, line 23 was replaced with an alternate sentence. For clarity, to make sure the correct sentence was actually replaced, Applicants would like to point out that it should have been the first sentence of paragraph [0022] beginning on "labeled" page 4 (the fifth page of the patent application if you count the title/coverpage. The Applicants respectfully request that the Examiner confirm that the first sentence of paragraph [0022] was replaced instead of some other sentence on the following page, and let the Applicants know if a correction needs to be made.

35 U.S.C. §103(a) Rejection – Richardson and Mital

The Examiner has rejected claims 32-54 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,028,764 issued to Richardson, et al. (hereinafter referred to as "Richardson") in view of U.S. Patent No. 5,878,282 issued to Mital (hereinafter "Mital"). The Applicants respectfully submit that, firstly, Richardson and Mital should not be combined, and secondly, that even if Richardson and Mital are combined, which does not even seem appropriate, the combination still does not teach or suggest the limitations of some of the independent claims.

(a) Richardson and Mital Should Not Be Combined

Firstly, Richardson and Mital should not be combined because: (1) Richardson and Mital are from different fields or non-analogous arts; and (2) there is no suggestion or motivation to combine Richardson and Mital.

Richardson pertains to a portable computer, such as a laptop, with a separable display screen (see e.g., Title). The display screen detaches from the remainder of the computer (see e.g., Abstract). When the screen is detached communication may continue between the screen and the remainder of the computer using wireless communication (see e.g., Abstract). In contrast, Mital pertains to a portable information device (see e.g., Title) having a form factor that is compatible with a 3.5" floppy or PCMCIA memory disk drive (see e.g., FIGS. 1, 2, and 4) that is generally used as a portable personal organizer (see e.g., column 1, line 21 and column 9, lines 43-65). The liquid crystal display (LCD) of the portable information device is not separable or detachable. Furthermore, the computer and the portable information device do not communicate with one another wirelessly. The computer does not use the LCD of the portable information device to display information. In fact, when the portable information device is inserted into the floppy or PCMCIA slot, the LCD would be concealed (as shown in FIG. 1).

As discussed in the MPEP 2141.01(a), to rely on a reference under 35 U.S.C. 103, it must be analogous prior art. *"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned."* In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). The problem addressed in Mital would not logically have commended itself to an inventor's attention when he/she was considering the problem addressed in Richardson. Further an inventor could not possibly be aware of every teaching in every art. In re Wood, 599

F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979). For at least these reasons, Richardson and Mital are from non-analogous arts and should not be combined.

Additionally, there is no suggestion or motivation to combine Richardson and Mital. To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In re Vacck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). There is no such suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The Examiner has stated that *"It would have been obvious to one of ordinary level of skill in the art to have modified Richardson with features of the processor for use in a detachable display as taught by Mital because the subsystem can be operated independently by using own processor even detaching from the main computer"*. Applicants respectfully submit that this motivation is insufficient. In Mital, once the portable information device is separated from the computer, and often physically separated from the computer by great distances, it does not communicate with the computer and does not use processing or other resources of the computer for its operation. Therefore the portable information device of Mital must have its own CPU. In contrast, the display screen and remainder of the computer of Richardson do not in fact operate independently as suggested by the Examiner. In fact, Richardson makes it clear that the display screen and remainder of the computer may communicate wirelessly with one another and that the display screen may use the processor resources of the remainder of the computer. Therefore, the motivation proposed by the Examiner to make the display screen of Richardson "independent" of the remainder of the computer goes

against the explicit teachings of Richardson who discloses that the display screen and remainder of the computer should not be independent of one another but rather should interact.

It is not correct merely to focus on the differences between the prior art and the claimed invention, and then to state that the differences themselves are obvious. The claimed invention as a whole is to be considered. Further, it is impermissible to use the patent application as the basis for the obviousness rejection. As the Federal Circuit has stated, "It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention'" (In re Fritch, 972, F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596,1600 (Fed. Cir. 1988)).

For at least these reasons mentioned above, the Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness and has failed to provide a justification for why Richardson and Mital should be combined.

(b) Any Combination of Richardson and Mital Does Not Teach or Suggest Limitations of Some of the Independent Claims

Claim 50 recites a computing display subsystem comprising "*a processor; a display controller; a storage device; a communication adapter to communicate with a base station when the computing display subsystem is detached from the base station; and a connector to allow the computing display subsystem to be connected and detached from the base station, wherein the processor is operable to operate at a higher frequency power mode when the computing display subsystem is connected to the base station, and at a lower frequency power mode when the computing display subsystem is detached*

from the base station". Any combination of Richardson and Mital does not teach or suggest these limitations.

In particular any combination of Richardson and Mital does not teach or suggest that a processor of the display subsystem operate at a higher frequency power mode and a lower frequency power mode. Mital does not teach or suggest that the CPU may operate at different frequencies.

For at least these reasons, claim 50 and its dependent claims are believed to be allowable over any combination of Richardson and Mital, which combination does not even seem appropriate.

Dependent claims 35, 36, 41, and 46-47 are believed to be allowable at least for reasons similar to those of claim 50.

Conclusion

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance. Applicants respectfully request that the rejections be withdrawn and the claims be allowed at the earliest possible date.

Request For Telephone Interview

The Examiner is invited to call Brent E. Vecchia at (303) 740-1980 if there remains any issue with allowance of the case.

Request For An Extension Of Time

The Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

Charge Our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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